ARGUMENTS/REMARKS AFTER FINAL

Claims 1-12 and 49-55 remain in the application. Reconsideration of the application is respectfully requested.

1. REAL PARTY IN INTEREST

The real party in interest for the purpose of these remarks is Motorola, Inc.

2. STATUS OF CLAIMS

These remarks are in response to a final Office Action dated January 16, 2004. Claims 1-12 and 49-55 remain in the application. In the final Office Action dated January 16, 2004, the Examiner rejected Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) as being clearly anticipated by Pepe et al (USPN 5,742,668).

No claims have been allowed. The claims have been reproduced above.

3. AMENDMENTS

No amendments have been made to the application.

4. SUMMARY OF INVENTION

A novel method for processing services in a communication system is proposed by Applicants. A demonstration of this method is exemplified by FIG. 2, 7-8 and at text starting at page 6, line 28. Applicants' Specification, page 6, line 28. In particular, the novel method requires "service processing logic" and "executing ... service processing logic."

5. ISSUE

Whether Claims 1-12 and 49-55 are patentable under 35 U.S.C. § 102(e) over Pepe?

6. GROUPING OF CLAIMS

Applicant designates the following group of claims:

Group I: Claims 1-12 and 49-55.

7. ARGUMENT

(i)   Rejection under 35 U.S.C. § 112, first paragraph:
      None.

(ii) Rejection under 35 U.S.C. § 112, second paragraph:
      None.

(iii) Rejection under 35 U.S.C. § 102

The Examiner has rejected Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) as being clearly anticipated by Pepe. After a careful review of Pepe and the claims, it is believed that the rejection is in error and the rejection is, therefore, traversed.

Applicants apologize if the Examiner feels that Applicants have failed to recognize or address Examiner's position in the Office Action dated May 8, 2003. Applicants will more clearly address Examiner's position of the Office Action dated May 8, 2003 in the remarks below. In summary, there are a number of reasons why the Applicants believe that the rejection from the Office Action dated May 8, 2003 and the final rejection dated January 16, 2004 are in error.

In particular, the Examiner asserts that "Pepe discloses in a communication system (Fig. 4) that includes a service provider (48) and a subscribers (30), a method for processing services comprises the steps of: indicating to the subscriber that the service provider is capable of supporting a service (col. 16, line 36-50); receiving service processing logic from the subscriber to allow the service provider to provide the service (see col. 18, lines 1-16 and col. 19, lines 66 to col. 20, line 52); executing the service processing logic received from the subscriber based on the

service processing logic when the service has been requested (see col. 18, lines 16-20)." Office Action, January 16, 2004, pages 2-3; Office Action, May 8, 2003, pages 2-3. Further, the Examiner asserts that "Pepe ... discloses PCI server 48 (corresponding to "service provider") receive e-mail notification (corresponding to "service processing logic") from PDA 30 (corresponding to "subscriber") (col. 18, lines 1-16)." Office Action, January 16, 2004, page 8. It is noted that the Examiner's reliance upon Pepe appears to be misplaced.

MPEP § 2131 provides:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim ....

Contrary to the Examiner's statement that all elements are disclosed in the Pepe reference, the term "service processing logic" and the step of "executing ... service processing logic" are not, so the rejection is unsupported by the art and should be withdrawn.

The Examiner defines "service processing logic" while discussing the step of "receiving service processing logic." The Examiner states that the step of "receiving service processing logic" is disclosed in "col. 18, lines 1-16 and col. 19, line 66 to col. 20, line 52." Office Action, January 16, 2004, page 3. Col. 18, lines 1-16 disclose a message flow of sending an e-mail from a PDA to a PCI server and disclose that a subsequent message be sent by the PCI server to the PDA to acknowledge receipt of the e-mail. Col. 18, lines 1-16. The Examiner appears to be stating that Pepe's disclosure of receiving an e-mail at a PCI server is the same as Applicants' claimed step of "receiving service processing logic." This is not true. Again, the Examiner appears to be stating that the Pepe's e-mail notification corresponds to Applicants' "service processing logic." See "Pepe ... discloses PCI server 48 (corresponding to "service provider") receive e-mail notification (corresponding to "service processing logic") from PDA 30 (corresponding to "subscriber") (col. 18, lines 1-16)." Office Action, January 16, 2004, page 8. Contrary to the Examiner's assertions, there is no correspondence between Pepe's e-mail or e-mail notification and the "service processing logic" of Applicants' claimed invention and will be further explained below.

In interpreting pending claim terms, the Examiner is reminded that MPEP 2111 requires that pending claims be given their broadest reasonable interpretation *consistent* with the specification. The term "service processing logic" as used in the claims is defined in the specification at various places including "e.g. the service processing application and/or user customization software," "[t]he service processing logic is stored in memory ... and may include the entire software application to process a particular service and/or customize custom user parameters, and "[t]he service processing logic includes at least one of a service application and customer user parameters." Applicants' Specification page 4, lines 21-22; page 7, lines 19-22; page 14, lines 20-24. Thus, MPEP 2111 requires that the term "service processing logic" be interpreted as defined at various places in the Applicants' Specification including the pages cited above. For Pepe's disclosure of e-mail or e-mail notification to correspond to the "service processing logic" of the claimed invention, Pepe's e-mail or e-mail notification must be defined as an "application" or "software." As is known to one or ordinary skill in the art and as is acknowledged in the Pepe reference, e-mail or e-mail notification is commonly known as a message and not as an "application" or "software." See col. 1, lines 17-21; col. 3, lines 48-51; col. 5, lines 49-54. In light of Applicants' Specification, Pepe's disclosure of e-mail or e-mail notification is not "service processing logic" as used in the claimed invention.

In the Office Action, January 16, 2004, page 9, the Examiner states that "[a]pplicants are reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." Applicants completely agree with the Examiner that limitations from the specification are not read into the claims; however, Applicants do not ask that the Examiner import limitations into the claims, but ask that the Examiner give the claims an interpretation *consistent* with Applicants' Specification. Interpreting "service processing logic" as e-mail or e-mail notification is *not* consistent with the specification. Applicants' Specification requires that "service processing logic" be defined as "e.g. the service processing application and/or user customization software," "[t]he service processing logic is stored in memory ... and may include the entire software application to process a particular service and/or customize custom user parameters, and "[t]he service processing logic includes at least one of a service application and customer user parameters." Applicants' Specification page 4, lines 21-22; page 7, lines 19-22; page 14, lines 20-24. Thus, the term "service processing

logic" is missing from the Pepe reference and thus the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

The Examiner states that the step of "executing ... service processing logic" is disclosed in "col. 18, lines 16-20" of the Pepe reference. Office Action, January 16, 2004, page 3. Col. 18, lines 16-20 discloses putting an e-mail in original order and forwarding the e-mail to a message transfer agent. For the Examiner to be correct in his assertion that Pepe discloses the elements of the present invention, the PCI server 48 would need to execute service processing logic received from the PDA. That, however, is not the case. The PCI server of Pepe does not "execute" service processing logic and further does not receive service processing logic from the PDA. The PCI server receives e-mail messages from the PDA and not "service processing logic" and further the e-mail messages that the PCI server receives from the PDA can not be executed by the PCI server. Thus, the step of "executing ... service processing logic" is missing from the Pepe reference. Since none of the cited passages disclose the step of "executing ... service processing logic," the Examiner's reliance on Pepe appears to be mistaken.

Contrary to the Examiner's statement that the Pepe reference discloses the Applicants' claimed invention, the term "service processing logic" and the step of "executing ... service processing logic" are missing from the Pepe reference. Thus, the rejection of Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

(iv)   Rejection under 35 U.S.C. § 103

None.

8. CONCLUSION

For all the above reasons, Applicants respectfully submit that the rejection of Claims 1-12 and 49-55 under 35 U.S.C. § 102(e) is in error and the claims be allowed.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to **Deposit Account 502117**.

Respectfully submitted,

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